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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,316	05/25/2001	Laurent Chapuis	TENS 1000-8US	4659

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/865,316	<b>Applicant(s)</b> CHAPUIS ET AL.	
	<b>Examiner</b> Sam Chuan C. Yao	<b>Art Unit</b> 1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 41-89 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 41-88, drawn to a method for making a composite. Independent claim 1 of this group requires, for example, “*selecting a first layer of material having circumferential edge; ... selecting lengths of the segments so that at least most of the segments extend only part way along the expected load lines; ...*” (emphasis added; **A**).
  - II. Claim 89, drawn to a method for making a composite. Independent claim 89 of this group requires, for example, “... *the arranging step comprising laterally staggering the ends of the segments to help reduce weak areas*” (emphasis added; **B**).

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are directed to distinct methods, where patentability in the independent claims of each group is based on divergent combination of method steps. As noted above, independent claim 1 requires patentable limitation **A**, but not **B**; while independent claim 89 require **B**, but not **A**. The differences between these groups are critical and significant to the extent that the inventions constitute prima facie patentably distinct combinations, absent evidence to the contrary. This can readily and clearly be demonstrated by a side-by-side comparison of the independent claims, noted earlier. Similarities of the independent claims are merely superficial, since certain significant limitations in one of the groups find no counterpart in the other group(s) and vice versa.

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Presently, no claim is generic. **Rejoinder of these two groups of method will be considered, upon indication of allowable subject matter, depending on the basis thereof.**

2. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II; and vice versa, restriction for examination purposes as indicated is proper.

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A: *"choosing step comprises selecting yarns as the segments";*

Species B: *"choosing step is carried out with at least some of the segments secured to a control strand to form a belt of segments";*

Species C: *"choosing step is carried out so that the mat elements of each mat comprise mat fibers";*

Species M: *"arranging step is carried out so that the mat elements of mat are oriented at a range of angles from 0° to 6°";*

Species N: *"arranging step comprises orienting the control strand generally perpendicular to the expected load lines";*

Species S: *"the optical projecting step is carried out by projecting the mat placement marks onto a tubular surface";*

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Species T: *"arranging step is carried by projecting continuous expected load lines onto the mat lay-up surface";*

Species U: *"the mat placement marks creating step comprises orienting the mat lay-up surface in a generally vertical orientation";*

Species V: *"the mat placement marks creating is carried out using the first layer as the mat lay-up surface";*

Species X: *"the capturing step is carried out using an elastomeric pressure element as the first pressure element";*

Species Y: *"the capturing step is carried out using first and second flexible pressure sheets as the 1<sup>st</sup> and second pressure elementst";*

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species among the various grouping of species: **(A-C), (M-N), (S-T), (U-V) and (X-Y)** for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 41 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Due the complexity of the restriction requirement, no attempt was made for Counsel to make a telephone election.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (703) 308-4788. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7115 for regular communications and (703) 305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Sam Chuan C. Yao  
Primary Examiner  
Art Unit 1733

scy  
August 6, 2003